

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
RSW920010064US1

In Re Application Of: Bredow et al.



Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/845,542	4/30/2001	Fadok, Mark A.	30449	3625	

Invention: **METHOD OF DISPLAYING A SHOPPING SUMMARY TO A SHOPPER WHO ACCESSES AN ELECTRONIC COMMERCE WEB SITE**

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DOCKET NO. RSW920010064US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bredow *et al.*

Examiner: Fadok, Mark A.

Serial No.: 09/845,542

Art Unit: 3625

Filed: 4/30/01

For: **METHOD OF DISPLAYING A SHOPPING SUMMARY TO A SHOPPER WHO
ACCESSES AN ELECTRONIC COMMERCE WEB SITE**

Commissioner for Patents
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BRIEF OF APPELLANT

This Appeal Brief, pursuant to the Notice of Appeal filed February 18, is an appeal from the rejection of the Examiner in the Office Action dated November 19, 2004.

REAL PARTY IN INTEREST

International Business Machines, Inc. is the real party in interest.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-21 are rejected. This Brief is in support of an Appeal from the rejection of claims 1-21.

STATUS OF AMENDMENTS

09/845,542

04/21/2005 AADD01 00000043 090457 09045542
01 FC:1402 500.00 DA

There are no After-Final Amendments which have not been entered. This Brief is in support of an appeal from the rejection of claims 1-21.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention discloses a method of presenting a shopping summary associated with electronic commerce, comprising the acts of: detecting a right click of a computer mouse on a web page; and showing a shopping summary in response to detecting the right click. See FIG. 2; specification, page 5, lines 8-19. The act of showing may further comprise the act of accessing a second web page that includes the shopping summary. See specification, page 6, lines 10-14. The act of showing may further comprise the act of opening a web page overlay that includes the shopping summary. See FIG. 4; specification, page 6, lines 19-20.

The present invention discloses a method of presenting a shopping cart for on-line shopping, comprising the acts of: detecting a right click of a computer mouse on an on-line shopping web page; and showing a shopping cart responsive to detecting the right click of the computer mouse on the on-line shopping web page. See FIG. 3; specification, page 6, lines 1-10. The act of showing may further comprise the act of accessing a second web page that includes the shopping cart. See specification, page 6, lines 10-14. The act of showing may further comprise the act of opening a web page overlay that includes the shopping cart. See FIG. 4; specification, page 6, lines 19-20.

The present invention discloses a method of presenting a bidding summary for an on-line auction, comprising the acts of: detecting a right click of a computer mouse on an on-line auction

web page; and showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page. See FIG. 5; specification, page 7, line 16 - page 8, line 5. The act of showing may further comprise the act of accessing a second web page that includes the bidding summary. See specification, page 8, lines 6-11. The act of showing may further comprise the act of opening an overlay that includes the bidding summary. See specification, page 6, lines 19-20; page 8, lines 15-17.

The present invention discloses a method of presenting a shopping summary for electronic commerce, comprising the acts of: detecting a right click of a computer mouse on a web page; deriving a screen location from screen; coordinates of the computer mouse; creating an overlay that includes a shopping summary; and showing the overlay upon the web page at the derived location. See specification, page 5, lines 8-19; page 6, lines 19-20; page 8, line 18 - page 9, line 4. The shopping summary may include a shopping cart, an auction-bid summary, a barter summary; or a rental summary. See specification, page 5, lines 17-19; page 9, lines 14-17.

The present invention discloses a method for presenting a shopping summary for electronic commerce, comprising the acts of: detecting a right click of a computer mouse on an electronic commerce web page; when the right click is detected, determining whether a shopping summary is shown; if the shopping summary is shown upon detection of the right click, retiring the shopping summary; and if the shopping summary is not shown upon detection of the right click, showing the shopping summary. See FIG. 3; specification, page 5, lines 8-19; page 6, lines 10-14. The shopping summary may be included in a second web page. See specification, page 6, lines 10-14. The shopping summary may be included in an overlay upon the electronic commerce web page. See FIG. 4; specification, page 6, lines 19-20. The shopping summary

may includes a shopping cart, an auction-bid summary, a barter summary; or a rental summary.

See specification, page 5, lines 17-19; page 9, lines 14-17.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sherr et al. (US 20020154157) in view of Official Notice.

ARGUMENT

GROUND OF REJECTION 1

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sherr et al. (US 20020154157) in view of Official Notice.

Claims 1-3

Appellants respectfully contend that claim 1 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 1. For example, Sherr in view of Official Notice does not teach or suggest the feature: “showing a shopping summary in response to detecting the right click”.

The Examiner argues: “Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a shopping summary in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, a shopping summary as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer.”

In response, Appellants respectfully contend that the Examiner’s statement of: “It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, a shopping summary as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that

was considered important enough to command the use of the right click option” is vague and indefinite, and reflects unsupported speculation by the Examiner.

Appellants have challenged the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner. The Examiner has responded in “Response to Arguments” in the office action mailed 11/19/2004 by stating: “Applicant requests that the examiner provide an evidentiary article to support his contention of official notice. In response, the examiner presents the helpcommunity article that teaches programmers how to program the right click button to add any functionality.” In response, Appellants note that the “helpcommunity article” merely provides instructions on how to add a right-click functionality to software and does not include any support for the Examiner’s argument as to why it is allegedly obvious to perform the step of “showing a shopping summary in response to detecting the right click”. In fact, Appellants respectfully contend that the “helpcommunity article” has no relevance as to whether claim 1 is unpatentable over Sherr in view of Official Notice. The issue is not whether a right-click functionality could be used with software. The issue is whether it is obvious to perform the step of “showing a shopping summary in response to detecting the right click”.

Appellants have repeatedly challenged the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner of: “It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option”. The inability of

the Examiner to produce a prior art reference in support of the Examiner's argument further demonstrates that the Examiner's argument is not persuasive.

Appellants respectfully contend that the Examiner's statement of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer" reflects unsupported speculation by the Examiner and is not disclosed in the prior art. Appellants reiterate that Appellants' prior challenge of the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner was not adequately responded to by the Examiner.

Appellants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner's unsupported allegation of Official Notice in relation to claim 1. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**")). The Examiner has not made any showing of where the prior art suggests "showing a shopping summary in response to detecting the right click". Additionally, the Examiner has not made any

showing of where the prior art teaches that “offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer”. Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner’s speculation using hindsight reconstruction in conjunction with the Examiner’s personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for “showing a shopping summary in response to detecting the right click”, and by not citing any teaching in the prior art of: “offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer”, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 1.

Based on the preceding arguments, Appellants respectfully maintain that claim 1 is not unpatentable over Sherr in view of Official Notice, and that claim 1 is in condition for allowance. Since claims 2-3 depend from claim 1, Appellants contend that claims 2-3 are likewise in condition for allowance.

In addition with respect to claim 2, Appellants contend that Sherr does not teach or suggest the feature: “wherein the act of showing further comprises the act of accessing a second web page that includes the shopping summary”.

The Examiner argues: “In response to claim 2, Sherr teaches wherein the act of showing further comprises the act of accessing a second web page that includes the shopping summary (see response to claim 1, order page)”.

In response, Appellants note that the Examiner’s argument for claim 2 has merely

referred back to the Examiner's argument for claim 1 and has therefore not addressed the aforementioned feature of claim 2 relating to "**a second web page** that includes the shopping summary" (emphasis added). Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 2.

In addition with respect to claim 3, Appellants contend that Sherr does not teach or suggest the feature: "wherein the act of showing further comprises the act of opening a web page overlay that includes the shopping summary".

The Examiner argues: "In response to claim 3, Sherr teaches wherein the act of showing further comprises the act of opening a web page overlay that includes the shopping summary (see response above and FIG 2, item 206)."

In response, Appellants note that the streaming box 206 of FIG. 2 of Sherr "may also be used to display information about one or more content pieces, for example, selected by the content service operator as promotional information for such content pieces" (see Sherr, Paragraph 0068). Therefore the alleged overlay 206 does not include the shopping summary as required by claim 3. Moreover, the Examiner has not provided any reason as to why it is allegedly obvious to modify Sherr to include the shopping summary in the streaming box 206 of FIG. 2 of Sherr. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 3.

Claims 4-6

Appellants respectfully contend that claim 4 is not unpatentable over Sherr in view of

of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 4. For example, Sherr in view of Official Notice does not teach or suggest the feature: “showing a shopping cart responsive to detecting the right click of the computer mouse on the on-line shopping web page”.

The Examiner argues: “see response to claim 1, and FIG 14”. In response, Appellants cite Appellants’ arguments relating to claim 1.

In addition, Appellants respectfully contend that FIG. 14 of Sherr depicts an “open order ticket page” (see Sherr, paragraph 0105, lines 1-3) which is not a “shopping cart”. A “shopping cart” comprises a list of goods **to be purchased** (see Appellants’ specification, page 1, lines 14-17). In contrast, an “open order ticket page” comprises a list of goods **previously purchased** (see Sherr, paragraph 0105, lines 1-8). Therefore, the Examiner’s citation of FIG. 14 of Sherr is not persuasive and the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 4.

Based on the preceding arguments, Appellants respectfully maintain that claim 4 is not unpatentable over Sherr in view of Official Notice, and that claim 4 is in condition for allowance. Since claims 5-6 depend from claim 4, Appellants contend that claims 5-6 are likewise in condition for allowance.

In addition with respect to claim 5, Appellants contend that Sherr does not teach or suggest the feature: “wherein the act of showing further comprises the act of accessing a second web page that includes the shopping cart”.

The Examiner argues: “In response to claim 5, Sherr teaches wherein the act of showing

further comprises the act of accessing a second web page that includes the shopping cart (see response to claim 1 and FIG. 14)”.

In response, Appellants note that the Examiner’s argument for claim 5 has merely referred back to the Examiner’s argument for claim 1 and FIG. 14 of Sherr depicts an open order ticket page which does not include a shopping card. Moreover, the Examiner has not provided any analysis or argument for combining FIG. 14 with the Examiner’s arguments relating to claim 1. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 5.

In addition with respect to claim 6, Appellants contend that Sherr does not teach or suggest the feature: “wherein the act of showing further comprises the act of opening a web page overlay that includes the shopping summary”.

The Examiner argues: “In response to claim 6, Sherr teaches wherein the act of showing further comprises the act of opening a web page overlay that includes the shopping cart (see response to claim 1, 3, and 5).”

In response, Appellants note that the Examiner’s argument for claim 3 referred to the streaming box 206 of FIG. 2 of Sherr as allegedly representing the claimed “overlay”.

Appellants further note, however, that the streaming box 206 of FIG. 2 of Sherr “may also be used to display information about one or more content pieces, for example, selected by the content service operator as promotional information for such content pieces” (see Sherr, Paragraph 0068). Therefore the alleged overlay 206 does not include the shopping cart as required by claim 6. Moreover, the Examiner has not provided any reason as to why it is

allegedly obvious to modify Sherr to include the shopping cart in the streaming box 206 of FIG. 2 of Sherr. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 6.

Claims 7-9

Appellants respectfully contend that claim 7 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 7. For example, Sherr in view of Official Notice does not teach or suggest the feature: “showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page”.

The Examiner argues: “Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a bidding summary in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue due to satisfying the needs of the customer.”

In response, Appellants respectfully contend that the Examiner has not produced even a single reference pertaining to an “on-line auction web page” and a “bidding summary” and has therefore failed to establish a *prima facie* case of obviousness in relation to claim 7.

In further response, Appellants respectfully contend that the Examiner’s statement of: “It

would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option” is vague and indefinite, and reflects unsupported speculation by the Examiner.

Appellants have challenged the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner. The Examiner has responded in “Response to Arguments” by stating: “Appellant requests that the examiner provide an evidentiary article to support his contention of official notice. In response, the examiner presents the helpcommunity article that teaches programmers how to program the right click button to add any functionality.” In response, Appellants note that the “helpcommunity article” merely provides instructions on how to add a right-click functionality to software and does not include any support for the Examiner’s argument as to why it is allegedly obvious to perform the step of “showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page”. In fact, Appellants respectfully contend that the “helpcommunity article” has no relevance as to whether claim 7 is unpatentable over Sherr in view of Official Notice. The issue is not whether a right-click functionality could be used with software. The issue is whether it is obvious to perform the step of “showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page”.

Appellants have repeatedly challenged the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner of: “It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in

Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option”. The inability of the Examiner to produce a prior art reference in support of the Examiner’s argument further demonstrates that the Examiner’s argument is not persuasive.

In addition, Appellants respectfully contend that the Examiner’s statement of: “offering this flexibility would increase the sale and use of the system and thus create increased revenue due to satisfying the needs of the customer” reflects unsupported speculation by the Examiner and is not disclosed in the prior art. Appellants reiterate that Appellants’ prior challenge of the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner was not adequately responded to by the Examiner.

Appellants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner’s unsupported allegation of Official Notice in relation to claim 7. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention”). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 (“The mere fact that the prior art could be so modified would not have made the

motivation obvious **unless the prior art suggested the desirability of the modification.**").

The Examiner has not made any showing of where the prior art suggests "showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page". Additionally, the Examiner has not made any showing of where the prior art teaches that "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer". Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner's speculation using hindsight reconstruction in conjunction with the Examiner's personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for "showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page", and by not citing any teaching in the prior art of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer", the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 7.

Based on the preceding arguments, Appellants respectfully maintain that claim 7 is not unpatentable over Sherr in view of Official Notice, and that claim 7 is in condition for allowance. Since claims 8-9 depend from claim 7, Appellants contend that claims 8-9 are likewise in condition for allowance.

In addition with respect to claim 8, Appellants contend that Sherr does not teach or suggest the feature: "wherein the act of showing further comprises the act of accessing a second web page that includes the bidding summary".

The Examiner argues: “In response to claim 8, Sherr teaches wherein the act of showing further comprises the act of accessing a second web page that includes the bidding summary (see response to claim 7, order page)”.

In response, Appellants note that the Examiner’s argument for claim 7 has merely referred back to the Examiner’s argument for claim 7 and has therefore not addressed the aforementioned feature of claim 8 relating to “**a second web page** that includes the bidding summary” (emphasis added). Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 8.

In addition with respect to claim 9, Appellants contend that Sherr does not teach or suggest the feature: “wherein the act of showing further comprises the act of opening a web page overlay that includes the bidding summary”.

The Examiner argues: “In response to claim 9, Sherr teaches wherein the act of showing further comprises the act of opening a web page overlay that includes the bidding summary (see response to claim 7 and FIG 2, item 206).”

In response, Appellants note that the streaming box 206 of FIG. 2 of Sherr “may also be used to display information about one or more content pieces, for example, selected by the content service operator as promotional information for such content pieces” (see Sherr, Paragraph 0068). Therefore the alleged overlay 206 does not include the bidding summary as required by claim 9. Moreover, the Examiner has not provided any reason as to why it is allegedly obvious to modify Sherr to include the bidding summary in the streaming box 206 of FIG. 2 of Sherr. Accordingly, the Examiner has failed to establish a *prima facie* case of

obviousness in relation to claim 9.

Claims 10-14

Appellants respectfully contend that claim 10 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 10. For example, Sherr in view of Official Notice does not teach or suggest the feature: “deriving a screen location from screen coordinates of the computer mouse; creating an overlay that includes a shopping summary; and showing the overlay upon the web page at the derived location.”

The Examiner argues: “Sherr discloses a method of presenting a shopping summary for electronic commerce, comprising the acts of: detecting a right click of a computer mouse on a web page (page 7, para 071); deriving a screen location from screen coordinates of the computer mouse (page 6, para 0067); creating an overlay that includes a shopping summary (FIG 2, item 206); and showing the overlay upon the web page at the derived location (FIG 2, item 206).”

In response, Appellants respectfully contend that Sherr does not teach or suggest “deriving a screen location from screen coordinates of the computer mouse” in Sherr, paragraph 0067. There is absolutely no disclosure of “screen coordinates of the computer mouse” in Sherr, paragraph 0067 or elsewhere in Sherr.

In additional response, Appellants respectfully contend that streaming box 206 in FIG. 2 of Sherr does not include a shopping summary, as required by claim 10.

In further response, Sherr **does not disclose** that streaming box 206 in FIG. 2 of Sherr is positioned at the screen location that was derived from the screen coordinates of the computer

mouse, as required by claim 10 (i.e., the screen coordinates are the “derived location” of claim 10) .

Based on the preceding arguments, Appellants respectfully maintain that claim 10 is not unpatentable over Sherr in view of Official Notice, and that claim 10 is in condition for allowance. Since claims 11-14 depend from claim 10, Appellants contend that claims 11-14 are likewise in condition for allowance.

In addition with respect to claims 11-14, Sherr does not teach or suggest: “wherein the shopping summary includes a shopping cart” (claim 11), “wherein the shopping summary includes an auction-bid summary” (claim 12), “ wherein the shopping summary includes a barter summary” (claim 13), and “wherein the shopping summary includes a rental summary” (claim 14).

With respect to claims 11-14, the Examiner argues: “Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing all the different summaries in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying summaries as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue by satisfying the needs of the customer.”

Appellants respectfully contend that the Examiner has not supplied a legally persuasive

argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner's unsupported allegation of Official Notice in relation to claims 11-14. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**").

The Examiner has not made any showing of where the prior art suggests: "wherein the shopping summary includes a shopping cart" (claim 11), "wherein the shopping summary includes an auction-bid summary" (claim 12), " wherein the shopping summary includes a barter summary" (claim 13), and "wherein the shopping summary includes a rental summary" (claim 14)". Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner's speculation using hindsight reconstruction in conjunction with the Examiner's personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for: "wherein the shopping summary includes a shopping cart" (claim 11), "wherein the shopping summary includes an auction-bid summary" (claim 12), " wherein the shopping summary includes a barter summary" (claim 13), and "wherein the shopping summary includes a rental summary" (claim 14)", the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims

11-14.

Claims 15-21

Appellants respectfully contend that claim 15 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 15. For example, Sherr in view of Official Notice does not teach or suggest the feature: “when the right click is detected, determining whether a shopping summary is shown.” The Examiner does not even allege that Sherr discloses said “determining” feature of claim 15.

As another example, Sherr in view of Official Notice does not teach or suggest the feature: “if the shopping summary is shown upon detection of the right click, retiring the shopping summary, and if the shopping summary is not shown upon detection of the right click, showing the shopping summary.”

The Examiner argues: “In response to claim 15, Sherr discloses using the right click of a mouse to perform a limited programmed function such as entering an order page within a current webpage (see response to claims 1-14), but does not specifically mention that the right click is used to open and close an application such as a shopping summary. Turning programs on and off utilizing a single on/off switch activation mechanism such as a mouse click is old and well known in the art. It would have been obvious to a person having ordinary skill in the art to change the right click programming to include on/off capability, because this would improve the system of Sherr by turning off a program that was activated with the right click and removing information that was not currently needed thus creating a less cluttered webpage.”

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In response, Appellants assert that Sherr does not disclose a “shopping summary” and Appellants cite Appellants’ arguments relating to claims 1 and 4.

In addition, the Examiner admits that Sherr does not disclose the decision logic in claim 15 of: “if the shopping summary is shown upon detection of the right click, retiring the shopping summary; and if the shopping summary is not shown upon detection of the right click, showing the shopping summary”.

Appellants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner’s unsupported allegation of Official Notice in relation to claim 15. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention”). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 (“The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**”). The Examiner has not made any showing of where the prior art suggests “when the right click is detected, determining whether a shopping summary is shown”. Additionally, the Examiner has not made any showing of where the prior art teaches that “this would improve the system of Sherr by turning off a program that was activated with the right click and removing information

that was not currently needed thus creating a less cluttered webpage”. Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner’s speculation using hindsight reconstruction in conjunction with the Examiner’s personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for “when the right click is detected, determining whether a shopping summary is shown”, and by not citing any teaching in the prior art of: “this would improve the system of Sherr by turning off a program that was activated with the right click and removing information that was not currently needed thus creating a less cluttered webpage”, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 15.

Based on the preceding arguments, Appellants respectfully maintain that claim 15 is not unpatentable over Sherr in view of Official Notice, and that claim 15 is in condition for allowance. Since claims 16-21 depend from claim 15, Appellants contend that claims 16-21 are likewise in condition for allowance.

In addition with respect to claim 16, Appellants contend that Sherr does not teach or suggest the feature: “wherein the shopping summary is included in a second web page”.

The Examiner argues: “In response to claim 16, Sherr teaches wherein the shopping summary is included in a second web page (see response to claim 1, order page)”.

In response, Appellants note that the Examiner’s argument for claim 16 has merely referred back to the Examiner’s argument for claim 1 and has therefore not addressed the aforementioned feature of claim 16 relating to **a second web page** included in the shopping summary” (emphasis added). Accordingly, the Examiner has failed to establish a *prima facie*

case of obviousness in relation to claim 16.

In addition with respect to claim 17, Appellants contend that Sherr does not teach or suggest the feature: “wherein the shopping summary is included in an overlay upon the electronic commerce web page”.

The Examiner argues: “In response to claim 17, Sherr teaches wherein the shopping summary is included in an overlay upon the electronic commerce web page (see response to claim 1, 3, and 5)”.

In response, Appellants note that the Examiner’s argument for claims 1, 3, and 5 referred to the streaming box 206 of FIG. 2 of Sherr as allegedly representing the claimed “overlay”. Appellants further note, however, that the streaming box 206 of FIG. 2 of Sherr “may also be used to display information about one or more content pieces, for example, selected by the content service operator as promotional information for such content pieces” (see Sherr, Paragraph 0068). Therefore the alleged overlay 206 does not include the shopping summary as required by claim 17. Moreover, the Examiner has not provided any reason as to why it is allegedly obvious to modify Sherr to include the shopping summary in the streaming box 206 of FIG. 2 of Sherr. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 17.

In addition with respect to claims 18-21, Sherr does not teach or suggest: “wherein the shopping summary includes a shopping cart” (claim 18), “wherein the shopping summary includes an auction-bid summary” (claim 19), “ wherein the shopping summary includes a barter

summary” (claim 20), and “wherein the shopping summary includes a rental summary” (claim 21)”.

With respect to claims 18-21, the Examiner argues: “Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing all the different summaries in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying summaries as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue by satisfying the needs of the customer.”

Appellants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner’s unsupported allegation of Official Notice in relation to claims 18-21. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention”). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 (“The mere fact that the prior art could be so modified would not have made the

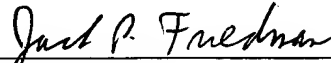
motivation obvious **unless the prior art suggested the desirability of the modification.**”).

The Examiner has not made any showing of where the prior art suggests: “wherein the shopping summary includes a shopping cart” (claim 18), “wherein the shopping summary includes an auction-bid summary” (claim 19), “ wherein the shopping summary includes a barter summary” (claim 20), and “wherein the shopping summary includes a rental summary” (claim 21)”. Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner’s speculation using hindsight reconstruction in conjunction with the Examiner’s personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for: “wherein the shopping summary includes a shopping cart” (claim 18), “wherein the shopping summary includes an auction-bid summary” (claim 19), “ wherein the shopping summary includes a barter summary” (claim 20), and “wherein the shopping summary includes a rental summary” (claim 21)”, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 18-21. .

SUMMARY

In summary, Appellant respectfully requests reversal of the November 19, 2004 Office Action rejection of claims 1-21.

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bredow *et al.*

Examiner: Fadok, Mark A.

Serial No.: 09/845,542

Art Unit: 3625

Filed: 4/30/01

For: **METHOD OF DISPLAYING A SHOPPING SUMMARY TO A SHOPPER WHO
ACCESSES AN ELECTRONIC COMMERCE WEB SITE**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPENDIX A - CLAIMS ON APPEAL

1. A method of presenting a shopping summary associated with electronic commerce, comprising the acts of:

detecting a right click of a computer mouse on a web page; and
showing a shopping summary in response to detecting the right click.

2. The method of claim 1, wherein the act of showing further comprises the act of accessing a second web page that includes the shopping summary.

3. The method of claim 1, wherein the act of showing further comprises the act of opening a web page overlay that includes the shopping summary.

4. A method of presenting a shopping cart for on-line shopping, comprising the acts of:

detecting a right click of a computer mouse on an on-line shopping web page; and
showing a shopping cart responsive to detecting the right click of the computer mouse on
the on-line shopping web page.

5. The method of claim 4, wherein the act of showing further comprises the act of accessing a
second web page that includes the shopping cart.

6. The method of claim 4, wherein the act of showing further comprises the act of opening a web
page overlay that includes the shopping cart.

7. A method of displaying a bidding summary for an on-line auction, comprising the acts of:
detecting a right click of a computer mouse on an on-line auction web page; and
showing a bidding summary responsive to detecting the right click of the computer mouse
on the on-line auction web page.

8. The method of claim 7, wherein the act of showing further comprises the act of accessing a
second web page that includes the bidding summary.

9. The method of claim 7, wherein the act of showing further comprises the act of opening an
overlay that includes the bidding summary.

10. A method of presenting a shopping summary for electronic commerce, comprising the acts

of:

- detecting a right click of a computer mouse on a web page;
- deriving a screen location from screen coordinates of the computer mouse;
- creating an overlay that includes a shopping summary; and
- showing the overlay upon the web page at the derived location.

11. The method of claim 10, wherein the shopping summary includes a shopping cart.

12. The method of claim 10, wherein the shopping summary includes an auction-bid summary.

13. The method of claim 10, wherein the shopping summary includes a barter summary.

14. The method of claim 10, wherein the shopping summary includes a rental summary.

15. A method for presenting a shopping summary for electronic commerce, comprising the acts

of:

- detecting a right click of a computer mouse on an electronic commerce web page;
- when the right click is detected, determining whether a shopping summary is shown;
- if the shopping summary is shown upon detection of the right click, retiring the shopping summary; and
- if the shopping summary is not shown upon detection of the right click, showing the shopping summary.

16. The method of claim 15, wherein the shopping summary is included in a second web page.

17. The method of claim 15, wherein the shopping summary is included in an overlay upon the electronic commerce web page.

18. The method of claim 15, wherein the shopping summary includes a shopping cart.

19. The method of claim 15, wherein the shopping summary includes an auction-bid summary.

20. The method of claim 15, wherein the shopping summary includes a barter summary.

21. The method of claim 15, wherein the shopping summary includes a rental summary.



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APPENDIX B - EVIDENCE

There is no evidence entered by the Examiner and relied upon by Appellants in this
appeal.



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APPENDIX C - RELATED PROCEEDINGS

There are no proceedings identified in the "Related Appeals and Interferences" section.